

**REMARKS**

By this amendment, claims 1-6, 8-25, 27-42, 44-59, and 61-71 are pending, in which claims 1-6, 8-25, 27-42, 44-59, and 61-71 are currently amended. No new matter is introduced.

First, Applicants acknowledge with appreciation the courtesy of a telephonic interview granted to Applicants' representatives on June 10, 2010 at which time the claimed invention was explained in view of especially *Hendricks et al.* (U.S. Patent No. 5,798,785) ("Hendricks") and *Hale et al.* (U.S. Patent No. 6,785,539) ("Hale"). During the interview, attempts were made to clarify that Hendricks does not disclose, as previously admitted by the Examiner, "before the broadcast content is broadcast" as recited in claim 11 and as further discussed below. Further, during the interview, attempts were made to clarify that Hale does not disclose "access at least one piece of content from a memory of the terminal in an offline manner" as recited in claim 1 and as further discussed below. No agreement was reached.

**Objections to Claim 33**

This objection is respectfully traversed. Applicants have amended dependent claim 33 to recite "the apparatus" pursuant to the Examiner's kind suggestion in the Office Action. Applicants, therefore, respectfully request withdrawal of the objections to claim 33.

**Claims 11-16, 18-19, 29-34, 46-51, 53, 63-68, and 70 were rejected under 35 U.S.C. § 102 as anticipated by Hendricks.**

With respect to the anticipation rejection based on Hendricks, Applicants respectfully traverse as the reference fails to teach all features of the claims.

Applicants stress that the factual determination of lack of novelty under 35 U.S.C. §102(b) requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Therasense, Inc. v. Beckton, Dickenson and Company*, 593 F.3d 1289 (Fed. Cir. 2010); *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). Further, as a matter of procedural due process of law, the Examiner is required to specifically identify where in an applied reference is alleged to disclose each and every feature of a claimed invention, particularly when such is not apparent. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). Moreover, there are many fundamental differences between the claimed features and Hendricks that scotch the factual determination that Hendricks identically discloses, or even remotely suggests, the claimed inventions.

For example, independent claim 11 recites, *inter alia*: “receive the content usage log including the at least one content usage statistic **before the broadcast content is broadcast.**” Independent claim 29 recites, *inter alia*: “determine to send the content usage log to a destination **before the broadcast content is broadcast.**” Independent claim 46 recites, *inter alia*: “determining to send the content usage log to a destination; and **thereafter determining to broadcast the broadcast content.**” Independent claim 63 recites, *inter alia*: “determining to send the content usage log to a destination **before the broadcast content is broadcast.**”

The Examiner, during his discussion of claim 11 on page 3 of the Office Action dated 03-22-10, does not even allege that Hendricks discloses sending or receiving the content usage statistic **before the broadcast content is broadcast**. Moreover, the Examiner, on page 10 and 17 of the Final Office Action dated 01/06/2010, admitted that Hendricks fails to disclose the above-noted distinguishing claim features. Although the Examiner attempted, in that Final Office Action, to fill in the blanks by turning to *Inoue et al.* (U.S. Patent No. 5,826,168) (“Inoue”), the Examiner conceded that his reliance on Inoue was misplaced in the Office Action dated 03/22/2010, stating that “Applicant's arguments presented in the appeal brief dated 12/09/2009 is persuasive and, therefore, the finality of office action dated 1/06/2009 is withdrawn.”

On the other hand, the Examiner, during his discussion of claim 29 on page 5 of the Office Action, does allege that Hendricks teaches receiving the content usage statistic **before the broadcast content is broadcast**. However, the Examiner referred to the same column, line numbers, and figures (Fig. 3 and cols. 9, lines 11-19) to allege that Hendricks teaches the above-noted claim features as he did when he admitted in the Final Office Action dated 01/06/2010 that Hendricks fails to disclose the same features.

Even assuming, *arguendo*, that the Examiner intended to allege that the Hendricks reference satisfies the above claim features as in the rejection to claim 29, the Office Action, on page 3 and 5, refers to col. 9, lines 11-19, which state the following:

The local cable company will in turn be in communication with the operations center 202 or a regional control center (not shown) **which accumulates return data from the set top terminal 220 for statistical or billing purposes**. In alternative system embodiments, the operations center 202 and the statistical and billing sites are collocated. Further, telephone lines with modems are used to transfer information from the set top terminal 220 to the statistical and billing sites. (Emphasis added).

However, the above reference to Hendricks does not disclose or mention that any content usage statistic is sent to or received by a destination **before the broadcast content is broadcast**. For instance, Hendricks does not mention that the **return data** is even associated with any particular future broadcast. Accordingly, it could not demonstrate that the **return data for statistical or billing purposes** is sent to or received by a destination **before the broadcast content is broadcast**.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference, based on the foregoing, it is clear that Hendricks does not anticipate independent claims 11, 29, 46, and 63. Applicants, therefore, submit that the imposed rejection of independent claims 11, 29, 46, and 63, and claims 12-16, 18-19, 30-34, 47-51, 53, 64-68, and 70 dependent therefrom, under 35 U.S.C. § 102 for anticipation based on Hendricks is not factually or legally viable and, hence, solicit withdrawal thereof.

**Claims 1-4, 6, 8-10, 20-23, 25, 27-28, 37-40, 42, 44-45, 54-57, 59, 61-62, and 71 were rejected under 35 U.S.C. § 103(a) for obviousness predicated upon Hendricks in view of Hale.**

With respect to the obviousness rejection based on Hendricks in view of Hale, Applicants respectfully traverse as the references fails to teach all features of the claims.

For example, independent claim 1 recites, *inter alia*: “a terminal configured to determine to **access at least one piece of content from a memory of the terminal in an offline manner** after receipt of the at least one piece of content, **the access of the at least one piece of content being a trigger to the terminal to determine to obtain its location.**” Independent claim 20 recites, *inter alia*: “determine to **access at least one piece of content from a memory in an offline manner** after receipt of the at least one piece of content, **the access of the at least one**

**piece of content being a trigger to determine to obtain a location of the apparatus.”**

Independent claims 37 and 54 recite, *inter alia*: “determining to **access at least one piece of content from a memory of a terminal in an offline manner** after receipt of the at least one piece of content, **the access of the at least one piece of content being a trigger to determine to obtain a location of the terminal.**”

Applicants kindly note that the language, as explained in the interview on June 10, 2010, “accessing at least at least once piece of content from a memory of a terminal in an offline manner” is defined in the Specification. Particularly, the Specification explains the distinction between **an online manner** and **an offline manner**. For instance, para. [0065] of the published application states the following:

As explained above, the terminal receives and stores one or more pieces of content (see block 100) and thereafter accesses one or more pieces of content (see block 102). In this regard, the piece(s) of content can be **received, stored and accessed in an online manner**. For example, the piece(s) of content can be **received, stored and accessed in a streaming manner**, with the stored piece(s) of content typically comprising a buffer before and/or during presentation by a respective application. Advantageously, the piece(s) of content can additionally or alternatively be **received, stored and accessed in an offline manner**. In such instances, **the terminal 10 can receive and store the piece(s) of content. Then, at some time after communicating with the source of the piece(s) of content to receive the content, and after storing the piece(s) of content, the terminal can access one or more of the stored piece(s) of content.**

The Examiner, on page 8 of the Office Action, admitted that the primary reference to Hendricks fails to disclose the above-noted distinguishing claim features. In attempting to fill in the blanks, the Examiner turned to Hale. However, the Examiner’s reliance on Hale is misplaced. In the attempt to satisfy the above claim features, the Office Action, on page 8, refers to col. 10, lines 35-67, which state the following (emphasis added):

**In particular embodiments, toys could include IR or RF receivers that respond to triggers located throughout a theme park and provide location**

**based information at each of those venues. For example, a stuffed animal could be triggered to speak or move while carried through different areas of a theme park, acting as a tour guide for a child.**

**The memory in the portable device may be used to automatically store usage patterns. The stored information may be used to alter a device's presentation, may be used for tracking user preferences, may be used to infer user location and direction, or may be used to identify missing codes and faulty transmitters.**

For example, a portable audio device user repeatedly visiting a location may hear different descriptions on visit 2, visit 3, etc. Repeated return visits to one location may infer a high user interest, so the device may present more and more detailed content on each visit.

**Information stored in a portable device may be retrieved via its transmitter.** The information gathered from many devices may be collected in a database. The database may contain the travel path and times, as well as the history of user requests (via pushbuttons or touch-screen.) The data may be anonymous, and analyzed to determine group behavior, identify popular locations, isolate busy and idle times, etc. A user could also enter personal information such as name, and the extracted data could be used to reconstruct vacation activities, or reminisce about favorite locations.

The data collected in the portable device may be matched against geographical information also stored in the portable device. Analyzing the locations visited and the sequence of the visits could infer a direction of future travel. The portable device could present content that suggested future destinations. (Emphasis added).

However, the above reference to Hale does not disclose **the access of the at least one piece of content from a memory of the terminal in an offline manner a trigger to the terminal to obtain its location.** At best, the Hale terminal is triggered when the terminal accesses a piece of content in an online manner. That is, the Hale terminal is triggered as soon as the piece of content is received by the terminal rather than being triggered when the content is accessed from memory in an offline manner.

In view of the foregoing, no *prima facie* case of obviousness has been established. Further, it is apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite basis for the asserted motivations been

established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin- Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of claims 1-4, 6, 8-10, 20-23, 25, 27-28, 37-40, 42, 44-45, 54-57, 59, 61-62, and 71 under 35 U.S.C. §103(a) for obviousness predicated upon Hendricks in view of Hale is not factually or legally viable and, hence, solicit withdrawal thereof.

**Claims 5, 24, 41, and 58 were rejected under 35 U.S.C. § 103(a) for obviousness predicated upon Hendricks in view of Hale and *Inoue et al.* (U.S. Patent No. 5,826,168) (“Inoue”).**

In the statement of the rejection the Examiner asserted that one having ordinary skill in the art would have been led to incorporate Inoue's teaching into Hendricks' and Hale's system for the purpose of accommodating the viewing schedule of a user by buffering the display of video signals transmitted by a broadcaster, thereby providing a true near video-on-demand service. This rejection is respectfully traversed.

Specifically, claims 5, 24, 41, and 48 depends from independent claims 1, 20, 37, and 46, respectively. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1, 20, 37, and 46 under 35 U.S.C. § 103(a) for obviousness predicated upon Hendricks in view of Hale. The additional reference to Inoue does not cure the previously argued shortcomings in the attempted combination of Hendricks and Hale.

Accordingly, no *prima facie* case of obviousness has been established. Further, it is apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite basis for the asserted motivations been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin- Wiley Corp.*, 837 F.2d 1044

(Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of claims 5, 24, 41, and 58 under 35 U.S.C. §103(a) for obviousness predicated upon Hendricks in view of Hale and in further view of Inoue is not factually or legally viable and, hence, solicit withdrawal thereof.

**Claims 17, 35, 52, and 69 were rejected under 35 U.S.C. § 103(a) for obviousness predicated upon Hendricks in view of Inoue.**

In the statement of the rejection the Examiner asserted that one having ordinary skill in the art would have been led to incorporate Inoue's teaching into Hendricks system for the purpose of accommodating the viewing schedule of a user by buffering the display of video signals transmitted by a broadcaster, thereby providing a true near video-on-demand service. This rejection is respectfully traversed.

Specifically, claims 17, 35, 52, and 69 depend from independent claims 11, 29, 46, and 63, respectively. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 11, 29, 46, and 63 under 35 U.S.C. § 102(b) as anticipated by Hendricks. The additional reference to Inoue does not cure the previously argued shortcomings of Hendricks.

Accordingly, no *prima facie* case of obviousness has been established. Further, it is apparent that even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite basis for the asserted motivations been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin- Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of claims 17, 35, 52, and 69 under 35 U.S.C. §103(a) for obviousness predicated upon Hendricks in view of Inoue is not factually or legally viable and, hence, solicit withdrawal thereof.



Therefore, the present application, as amended, overcomes the objection and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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